

## REMARKS

In the Office action mailed December 16, 2005, claims 16, 17, and 50 were rejected under 35 U.S.C. § 101. Claims 1-15, 19-22 and 70 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,830,224 ("Cohn et al."). Claims 50, 52, and 53 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,728,122 ("Leschinsky et al."). Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohn et al. in view of Leschinsky et al. Claims 35, 37, 38, 40, 71, and 72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flaherty et al. in view of Leschinsky et al. Claims 36, 39, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flaherty et al. in view of Leschinsky et al. and further in view of Cohn et al. Claims 51, 54, 73 and 74 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Leschinsky et al. in view of Cohn et al.

Claims 16, 17, 50, 70 and 71 have been amended; and claims 54, 73 and 74 have been canceled without prejudice. Reconsideration of the present application is respectfully requested.

### SECTION 101 REJECTION

Claims 16, 17, and 50 were rejected under 35 U.S.C. § 101 for allegedly claiming the anatomical structure. Apparatus claims 16 and 17 have been amended to add the "adaptable" language as suggested by the Examiner. However, it does not appear suitable to amend method claim 50 in a similar manner. Nonetheless, Applicant has amended claim 50 in an attempt to address the Examiner's concerns.

## REJECTIONS BASED ON FLAHERTY

Claims 35, 37, 38, 40, 71, and 72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flarherty et al. in view of Leschinsky et al. Claims 36, 39, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flaherty et al. in view of Leschinsky et al. and further in view of Cohn et al.

There appears to be agreement that Flaherty et al. does not teach the use of external markers. As noted earlier, Flaherty discloses a marker on a tissue penetrating catheter used for bypass procedures, where the marker is within the blood vessel when in use.

The Office action relies on column 2, lines 24-29 of Lieschinsky et al. to teach the use of reference marks. However, like Flarherty, this is not an external mark, but a mark on the device itself. *See, e.g.*, Lieschinsky et al. at col. 5, lines 12-14 ("In FIG. 2 it can be seen that sheath 14 is provided with a reference mark 28.").

Applicant respectfully submits that neither Flaherty et al. nor Leschinsky discloses the claimed step of "marking externally the desired location," or the claimed "external marking" recited in independent claim 35. Applicant respectfully requests that the rejections of claims 35-41 based (in part or in whole) on Flaherty et al. and Lecshinsky et al. be withdrawn.

## REJECTIONS BASED ON COHN

Claims 1-15, 19-22, and 70 were rejected under Section 102(b) as being anticipated by Cohn '224; claims 16 and 17 were rejected under Section 103(a) as being unpatentable over Cohn '224 in view of Leschinsky et al.

There was no rejection of dependent claim 18. Applicant respectfully submits that this claim is allowable over the art applied in the Office action.

The Office action asserts that "Cohn teaches cutting tissue, it is still applying energy to the structure and eventually leading to smaller structure (col. 19 lines 8-28)." However, the passage in Cohn et al. referenced in the Office action makes no reference to leading to smaller structures. Instead, the passage refers to a catheter which provides the "means by which to perforate the vascular walls of closely associated veins and arteries concurrently." Perforating a vascular wall creates a hole through the vascular wall. In this way, two blood vessels may be connected. Applicant disagrees with the inference that this must necessarily lead to a smaller structure, and respectfully submits that the claims are allowable over Cohen et al.

Dependent claim 70 has also been amended to more clearly recite that the step of applying energy heats but does not cut the hollow anatomical structure. This heating effect reduces the diameter of the hollow anatomical structure which results in occlusion of the hollow anatomical structure. An occlusion is not a fistula. As previously discussed, Cohn et al. is directed to a catheter for generating a fistula between blood vessels (*i.e.*, an abnormal passage that connects the blood vessels). Cohn et al. teaches the use of a pair of catheters in tandem, with each catheter being inserted into each of the

blood vessels, and there appears to be agreement that these catheters cut tissue or perforate the vascular wall. Dependent claim 70 has been amended to exclude the hollow anatomical structure being cut in the step of applying energy.

Applicant respectfully requests that the rejections of claims 1-22 and 70-71 based on Cohn et al. be withdrawn.

#### REJECTIONS BASED ON LESCHINSKY

Claims 50, 52, and 53 were rejected under 35 U.S.C. § 102(b) as being anticipated by Leschinsky et al.; and claims 51, 54, 73 and 74 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Leschinsky et al. in view of Cohn et al.

Applicant respectfully submits that there is no motivation to combine the teachings of Leschinsky for plugging an arterial wound with the teachings of Cohn for creating a fistula. The only motivation appears to be hindsight in view of Applicant's invention.

Claim 50 has been amended to recite the step of "applying energy to the hollow anatomical structure at the treatment site via an energy application device at the working end of the catheter to heat but not cut the hollow anatomical structure until the hollow anatomical structure durably assumes a smaller size such that the reduced diameter of the hollow anatomical structure effectively ligates the hollow anatomical structure." As noted earlier, there appears to be agreement that the catheters in Cohen et al. cut tissue or perforate the vessel. Applicant respectfully requests that the rejections of claims 50-53 based on Leschinsky et al. in view of Cohn et al. be withdrawn.

CONCLUSION

Applicant respectfully submits that the pending claims are allowable, and respectfully requests favorable reconsideration of the present application at an early date. If the Examiner has any comments or questions regarding any of the foregoing, kindly telephone the undersigned.

Respectfully submitted,

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